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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,960	04/17/2000	Richard C. Levine	065581.0105	1648

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Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,960

Applicant(s)

LEVINE, RICHARD C.

Examiner

Richard Woo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-168 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-76 and 128-154 is/are allowed.
- 6) ☒ Claim(s) 1-38, 77-127 and 155-168 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1) Applicant's response filed May 24, 2004 has been acknowledged and entered.

Applicant's arguments, with respect to section 112 rejections have been fully considered and are persuasive. The corresponding rejections of the previous office action have been withdrawn.

- In response to the applicant's argument that the rejected claims are directed to various methods of routing an object in a transportation network, the examiner respectfully traverses the argument for the following reasons.

It is noted that essential technological features (such as computer, processor, server or other pertinent technological arts in the field of network) constituting applicant's invention, routing an object in a transportation network, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Notwithstanding a statement of intended use carries some patentable weight in a method claim, the claimed invention lacks patentable utility because there is not technological step involved in the claimed invention. The invention merely describes 'routing an object' or delivering the object (e.g. mail or parcel) in association with a corresponding address and code, which could be possibly done with a conventional delivery system (a manual activity can accomplish the same delivery or routing result). *Ex parte Bowman*, 61 USPQ 2d 1669 (BdPatApp&Int 2001).

Although the applicant has amended the claims to include "processing environment", it is noted that the changes do not sufficiently provide **computer implementation or any other technology** to the claims to overcome the rejection because the mere processing environment could suggest a manual processing, which is not requiring any computer implementation or other essential technology.

The examiner invites an applicant's attention to a core definition of Class 705 as follows: "this is the generic class for apparatus and corresponding method for performing data processing operations, in which there is a significant change in the data or for performing calculation operation wherein the apparatus or method is uniquely designed for or utilized in the practice, ..." For classification herein, there must be significant claim recitation of the data processing system or calculating computer and only nominal claim recitation of any external art environment.

In order to establish *quid pro quo* between an inventor and the general public, the inventor is obligated to disclose the exact meets and boundaries regarding his/her invention such that the general public could be benefited from the invention and further to promote or improve it. Generally, the classification system of the U.S. Patent Office provides a guidance to this meets and boundaries. If an applicant does not honor the classification system, the general public would be deprived of the right to know the meets and boundaries with respect to the applicant's invention.

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 101

3) Claims 1-38, 77-127 and 155-168 are rejected under 35 U.S.C. 101 because the claimed invention the claimed invention is directed to non-statutory subject matter. See the reasons as recited earlier in the response to arguments. See Claim 128 of the instant application to see how the applicant has claimed the invention within the technological arts so as to overcome the section 101 rejections.

Allowable Subject Matter

4) Claims 39-76 and 128-154 are allowed.

Conclusion

5) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
August 7, 2004



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600